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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,319	09/25/2001	Misako Suwa	826.1757	5814
21171	7590	11/30/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			FILIPCZYK, MARCIN R	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/961,319

Applicant(s)

SUWA ET AL.

Examiner

Marc R. Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,7,8,11,14,15,18 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,8,11,14,15,18 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 1,4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to Applicant's RCE and amendment filed October 25, 2006.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/2006 has been entered.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-25 are pending and new claim 26 is submitted.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: the term "sting" should be replaced with "string".

Claims 4 and 7 depend from claim 1 and are therefore objected on the same basis.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claims 25 and 26 do not involve transformation of article or physical object to a different state or thing, it merely recites extracting data or removing data, respectively. Further, independent claims 25 and 26 do not produce a useful, concrete, and tangible result, but merely search for a keyword, they do not permanently change the data or store search results for reuse. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claims 25 and 26 taken as a whole are directed to a mere method, do not comprise a practical application as explained above hence are nonstatutory.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1, 8, 15, 22, 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation “**result indicating... electronic document or said character strings**” was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 4, 7, 11, 14, 18 and 21, depend from claims 1, 8 and 15 and are therefore rejected on the same basis.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 8, 15, 22, 23 and 24, the limitation of “**result indicating... electronic document or said character strings**” is indefinite. It is not clear how a result indicates whether the answer is derived from an electronic document of character strings. Further it is not clear what is the difference between electronic document and character strings.

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Regarding claim 25, the term "result" is indefinite. It is not clear what the metes and bounds of result are as claimed.

Regarding claim 26, the limitation "removing contents printed on an electronic document... subsequent to printing and storing" is indefinite. It is not clear what contents are printed and removed.

Regarding claims 4, 7, 11, 14, 18 and 21, depend from claims 1, 8 and 15 and are therefore rejected on the same basis.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching (U.S. Patent No. 6,533,168) in view of Takeda et al (U.S. Patent No. 4,748,678).

Regarding claims 1, 8, 15 and 22-26, Ching discloses a method, program and system for electronically managing a note taken in a paper document printed from an "electronic document not including the note" (hereafter, original document) when the document is printed and used by a person, comprising: (figures 1a and 3, item 304, and col. 4, lines 9-14, Ching)

reading as an image a document printed on a paper, said document having a note written thereon (col. 4, lines 9-14, 17 and 18, Ching)

extracting information about the note from the read image of the document printed on the paper and a note handwritten on the paper; (col. 4, lines 9-14, Ching)

recognizing a character written in the image data of the note; (col. 10, lines 32-41, Ching)

searching (*purchaser*, fig. 9, item 903, Ching) attributes and contents of the electronic document and the recognition result of character contents of the hand written-note (fig.7, *search* and *database*, fig. 9, item 912, Ching) in accordance with a search keyword input from a user (*purchased request*, fig. 9), and displaying a search result indicating whether the search keyword is contained in the attributes and contents of the electronic document and said character strings; (fig. 1b, item 112 and fig. 9, *database*, and also see col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, “*relationships specified by the user*”, “*identifier symbols*” and “*mapping*” Ching)

(*Note 1: database includes contents of electronic document and the recognition result, see support [col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, Ching]*)

(*Note 2: information is stored in database for retrieval/search*)

(*Note 3: extracting is equivalent to removing*)

correlating and electronically storing the information about the note with the read image (col. 4, lines 14-17, and col. 10, lines 32-43, Ching) but does not explicitly teach correlating the original document with the information about the note and that the image data of the note is obtained by taking a difference between the original document and the read image.

However, Takeda teaches storing and retrieving image system that correlates an original document with information about a note (figures 7, 8, 11 and col. 9, lines 3-20, Takeda) and

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obtaining an image of the note by taking the difference between the original document and the read image (figures 7 and 8, Takeda).

Hence, having Ching system correlating information about the note with the read image (col. 10, lines 40-42, Ching), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to correlate the information about the note with the original document as done in Takeda. One would have been motivated to store the correlation information about the note and the original document to keep track of the note and the related original document to avoid storing the read image which includes the original document with a note.

Further, having Ching system, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to obtain an image of the note by taking a difference between the original document (receipt) and the read image (receipt with note) as done in Takeda (figures 7 and 8, Takeda). One would have been motivated to take the difference between the receipt and the receipt with a note to exclusively store the image of the note for future processing.

*(Note: obtaining an image of the note by taking the difference between the original document and the read image is shown in fig. 7 and supported by location attributes in fig. 8 of Takeda)*

Regarding claims 4, 11 and 18, Ching/Takeda disclose the original document, a note image and a recognition result of the hand written note image are correlated and electronically stored (figures 7, 8, 11 and col. 9, lines 3-20, Takeda, see also [col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, Ching]).



Regarding claims 7, 14 and 21, Ching/Takeda disclose location information of the note within the printed document (fig. 8, Takeda).

### *Response to Arguments*

Applicant's amendment and arguments filed on October 25, 2006 have been fully considered but they are not persuasive. The arguments and responses are listed above.

Applicant argues on page 8 of the response that amended claim 25 comprises a result, and is now statutory.

Examiner disagrees. It is not clear from the claimed limitation whether a result is generated or what the result is. As such the claim is rejected as being indefinite. Further, in order to overcome the rejection, Applicant is reminded that the metes and bounds of a generated result must be definite, must be stored in memory so that it can be useful, concrete and tangible, and a practical application of the result or claim as a whole should be included in the claim.

Applicant argues on pages 9 and 10 that Takeda and Ching do not teach the claimed limitations including a "result indicating... electronic document or said character strings".

Examiner disagrees. Ching discloses searching data from a database using a user submitted search wherein the database comprises electronic document information and annotation information including a handwritten note (see col. 4, lines 14-24, lines 49-54,

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*“relationships specified by the user”, “identifier symbols” and “mapping” Ching*, for more information please refer to the rejection above).

Ching system also discloses a database with contents of documents and annotations wherein notes are taken and are associated together, are stored in database for later retrieval based on user search. Please see also (*col. 10, lines 39-42 and col. 14, lines 3-9, and figures, Ching*). Takeda further teaches storing and correlating an original document with information about a note (figures 7,8,11 and col. 9, lines 3-20, *Takeda*). Together Ching/Takeda teach the claimed system.

No other arguments have been raised.

With respect to all the pending claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-26, Examiner respectfully traverses Applicant's assertion based on the discussion cited above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

November 22, 2006

  
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